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Russell W. Warnock

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Name of Attorney Signing

Russell W. Warnock
Signature

Russell W. Warnock, Reg. No. 32,860
Printed Name

BSH Home Appliances Corporation
100 Bosch Boulevard
New Bern, NC 25862
Phone: 252-672-7927
Fax: 714-845-2807
russ.warnock@bshg.com



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Examiner: James Orville Hansen
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DOOR

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AMENDED APPEAL BRIEF

Appellants herewith file an amended Appeal Brief in the above-identified application. The Appeal Brief was accompanied by the requisite fee set forth in 37 CFR 1.17(f) on April 16, 2008. This amended Appeal Brief is filed in response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) dated April 29, 2008.

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(1) REAL PARTY IN INTEREST

The real party in interest is BSH Bosch und Siemens Hausgeraete GmbH.

(2) RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) STATUS OF CLAIMS

Claims 1 - 8, 13, 15, 16, and 18 have been cancelled. Claims 9 -12, 14, 17 and 19-21 are pending in the present application. Claims 9 -12, 14, 17 and 19-21 have been finally rejected. The final rejections of claims 9 -12, 14, 17 and 19-21 are being appealed.

(4) STATUS OF AMENDMENTS

In response to the Final Rejection dated November 21, 2007, a Notice of Appeal was received in the US Patent Office on February 25, 2008. No other amendment has been filed subsequent to the Final Rejection dated November 21, 2007.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

CLAIM 9

Independent claim 9 of the present application recites a storage compartment for a refrigerator door (1) that includes a box shaped body in the form

of a box-shaped door storage compartment (5) [Paragraph 0026 and Figures 1 - 7] and a compartment divider (8) [Paragraph 0027 and Figures 1 - 7]. The compartment divider (8) of the inventive storage compartment includes a rider (14) extending downwardly spaced from a wall (12) thereof located adjacent to the slot for being received within the slot for holding the compartment divider attached within the box shaped body. The box-shaped door storage compartment (5) [Paragraph 0026] has a first longitudinal wall and a second longitudinal wall (12, 13) and a given depth extending substantially horizontally between the first and second longitudinal walls with a slot (15) extending vertically within the first longitudinal wall at least along a portion thereof [Paragraph 0028]. Also, the compartment divider (8) defines a chamber (17) for holding small items and extending over more than half of the given depth, wherein the compartment divider is defined by four connected walls (9, 10, 11) which do not extend to a bottom of the box shaped body to define the chamber within the connected walls for holding items therein, and an open bottom for allowing items held therein to rest on the bottom of the box shaped body [Paragraph 0028].

CLAIM 19

Independent claim 19 of the present application recites a storage compartment for a refrigerator door (1) that includes a box shaped body in the form of a box-shaped door storage compartment (5) [Paragraph 0026 and Figures 1 - 7] having a first longitudinal wall (12) disposed adjacent to the refrigerator door, a second longitudinal wall (13) spaced apart from the first longitudinal wall and extending substantially parallel to the first longitudinal wall, a bottom, and a slot (15) formed in the first longitudinal wall, the box shaped body having a width dimension extending along the first longitudinal wall in a substantially horizontal direction, a depth dimension extending between the first and second longitudinal walls, and a height dimension extending along the first longitudinal wall in a

substantially vertical direction [Paragraph 0028 and Figures 1 - 7]. The storage compartment also includes a compartment divider (8) [Paragraph 0027 and Figures 1 - 7] including a first sidewall disposed adjacent the first longitudinal wall (9), a second sidewall (10) spaced apart from the first sidewall a first distance being more than half of the depth dimension of the box shaped body, and third and fourth sidewalls (11) extending between the first and second sidewalls on opposing sides of the compartment divider, the compartment divider defining a chamber (17) within the sidewalls and having an open bottom allowing items held within the compartment divider to rest on the bottom of the box shaped body. The storage compartment further includes a rider (14) connected to the first sidewall and extending downwardly and being received within the slot to support the compartment divider within the box shaped body [Paragraph 0028 and Figures 1 - 7].

THE REFERENCES

German publication G 90 14 463 discloses a compartment 20 in the shape of a tub and mounted on a refrigerator door [English language Abstract and Figures 1 – 4]. A groove 25 is formed along an upper rear edge 24 of a side of the compartment 20 that is mounted to a refrigerator door [English language Abstract and Figures 1 – 4]. A form piece 22 has a rider 27 slidably supported in the groove 25 that can be selectively displaced along the groove in a longitudinal direction of the compartment 20 and the form piece 22 is subdivided into box areas 30 that are open on their top side [English language Abstract and Figures 1 – 4]. The form piece 20 retains small items within the compartment 20. The form piece 22 is configured such that its bottom side is at a spacing above a floor 29 of the compartment 20 yet this bottom side is not “open” – that is, the bottom side of the form piece 22 is closed off and does not permit an item retained in the form piece 22 to extend downwardly beyond the form piece.

Japanese publication 2001-74359 discloses a container for a refrigerator door having a cylinder 1a with an open bottom [English language Abstract and Figures 1 – 4 and 7]. A small item such as a small article tube can be retained in the cylinder 1a with the lowermost portion of the small article extending downwardly beyond the bottom of the cylinder 1a [English language Abstract and Figures 1 – 4 and 7].

Japanese publication 1-219483 discloses a divider 8 within a box shaped body 7 that defines a storage container for a refrigerator wherein the divider includes a concave shape for dividing tall items [English language Abstract and Figure 6].

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- a. Whether claims 9-11, 14, 17 and 19-20 are unpatentable under 35 USC §103(a) over German publication G 90 14 463 in view of Japanese publication 2001-74359?
- b. Whether claims 12 and 21 are unpatentable under 35 USC §103(a) over German publication G 90 14 463 in view of Japanese publication 2001-74359 and further in view of Japanese publication 1-219483?

(7) ARGUMENT

- a. Whether claims 9-11, 14, 17 and 19-20 are unpatentable under 35

USC §103(a) over German publication G 90 14 463 in view of Japanese publication 2001-74359?

The Examiner asserts that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the divider of German publication G 90 14 463 so as to utilize an open bottom as unequivocally taught by Japanese publication 2001-74359 because this arrangement would enhance the retaining capacity of German publication G 90 14 463's divider when long items are desired to be held within the chamber since the open bottom would afford additional storage capacity with enhanced holding capabilities of the long items [since the item is now seated within the divider as opposed to being seated upon the divider] in order to safely retain the items as clearly demonstrated by Japanese publication 2001-74359 [due to pivoting motion exhibited on the items when the refrigerator door is swung open and shut]."

Appellants respectfully disagree and note that a proposed modification cannot render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The intended purpose of formed part (22) with the closed shelf bottom (30) of German publication G 90 14 463, as shown in Fig. 3 of German publication G 90 14 463, is to provide an enclosed bin that retains smaller items in a confined receptacle within the refrigerator door storage compartment. These smaller items can be placed within the bin to prevent them from being scattered around the larger door storage compartment. If the formed part (22) of German publication G 90 14 463 was modified to eliminate the closed shelf bottom, as suggested by the Examiner and taught by Japanese publication 2001-74359, then the small items would fall out the open bottom and be scattered around the door storage compartment. The opening and closing movement of the door would cause the items to be moved within the larger door storage compartment and they could be crushed if a larger item, such as a gallon

of milk, was then unknowingly placed on the item. Allowing the smaller items to fall out of the bin and be damaged would render the prior art unsatisfactory for its intended purpose of retaining these items in a confined receptacle. Therefore, there is no apparent reason to make the proposed modification.

The open bottom divider structure of Japanese publication 2001-74359 is intended for an entirely different purpose than the closed bottom container of Fig. 3 in German publication G 90 14 463. As described by the Examiner, the open bottom divider structure of Japanese publication 2001-74359 is useful to help prevent longer items from tipping over. However, German publication G 90 14 463 provides a different embodiment, as shown with tongue (31) in Fig. 4, to satisfy this purpose. German publication G 90 14 463 describes how the tongue (31) embodiment is useful for preventing bottles or long tubes from tipping over.

For these and other reasons, German publication G 90 14 463 and Japanese publication 2001-74359, either alone or in combination, do not teach or suggest the subject matter defined by independent claim 9. Claims 10, 11, 14, 17 and 19-20 depend from claim 9 and are allowable for the same reasons and also because they recite additional patentable subject matter.

It is therefore asserted that the outstanding rejections of 9-11, 14, 17 and 19-20 under 35 U.S.C §103(a) are in error and should be reversed.

b. Whether claims 12 and 21 are unpatentable under 35 USC §103(a) over German publication G 90 14 463 in view of Japanese publication 2001-74359 and further in view of Japanese publication 1-219483?

Initially it should be noted that claim 12 depends from claim 9 and claim 9 has been shown above to be in condition for allowance. Claim 12 further recites that the compartment divider of claim 9 has at least one sidewall with a concave

shape in a direction of said given depth. Therefore, it is respectfully asserted that claim 12 is likewise in condition for allowance. Claim 21 further recites that the third and fourth sidewalls of the compartment divider of Claim 19 each have a concave shape bulging inwardly toward the chamber. The Examiner takes the position that it would have been obvious to further combine Japanese publication 1-219483 with the teachings of German publication G 90 14 463 and Japanese publication 2001-74359 to provide a compartment divider having a concave sidewall. Appellants respectfully disagree.

First, Japanese publication 1-219483 does not disclose a sidewall having a concave shape bulging inwardly toward a chamber. Rather, Japanese publication 1-219483 shows a divider (8) with the end of the top panel having a curved shape. As clearly shown in Fig. 6 of Japanese publication 1-219483, the curved portion is only on the edge of the top portion and does not extend downwardly. Therefore, this is not a curved sidewall as defined in the claims. Claim 19 recites that the third and fourth sidewalls extend between the first and second sidewalls on opposing sides of the compartment divider. Nothing in Japanese publication 1-219483 provides any disclosure of a sidewall having a concave shape bulging inwardly. Furthermore, the top panel of the divider (8) is a solid panel. Even if this edge could be considered a sidewall, it does not bulge inwardly toward a chamber, since Japanese publication 1-219483 does not disclose a chamber.

Second, it would not have been obvious to combine the references because Japanese publication 2001-74359 clearly teaches away from the proposed modification. As shown in Fig. 1 of Japanese publication 2001-74359, the container has multiple cylinder portions with convex shaped sidewalls that bulge outwardly away from the inner chamber. Also, the abstract of Japanese publication 2001-74359 specifically discusses how the outwardly bulging cylindrical shape is designed to house tube shaped articles.

Prior art must be considered in its entirety, including disclosures that teach away from the claimed invention. The Examiner cannot conveniently select some

portions of the secondary reference to fill the gaps in the primary reference while disregarding other portions of the references that teach away from the proposed combination. Most, if not all, inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, mere identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. “It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The Examiner has proposed modifying the teachings of German publication G 90 14 463 and Japanese publication 2001-74359 to result in a container having a shape being exactly the opposite of the shape specifically required in Japanese publication 2001-74359. Appellants believe such a modification would not have been obvious to one of ordinary skill in the art following the teachings of Japanese publication 2001-74359. The container (1) of Japanese publication 2001-74359 having convex shaped sidewalls that bulge outwardly away from the inner chamber teaches away from the Examiner’s proposed modification. Therefore, it would not have been obvious to make the proposed modification and there is no apparent reason to make the proposed modification.

For these and other reasons, German publication G 90 14 463, Japanese publication 2001-74359 and Japanese publication 1-219483, either alone or in combination, do not teach or suggest the subject matter defined by Claims 12 and 21. Therefore, Claims 12 and 21 are allowable.

It is therefore asserted that the outstanding rejection of claims 12 and 21 under 35 U.S.C §103(a) is in error and should be reversed.

(8) CONCLUSION

In view of the foregoing discussion, it is respectfully requested that the Honorable Board of Patent Appeals and Interferences overrule the final rejection of Claims 9-12, 14, 17 and 19-21 over the cited art, and hold that the Appellants' claims be allowable over such art.

Respectfully submitted,



Russell W. Warnock
Registration No. 32,860
May 27, 2008

BSH Home Appliances Corporation
100 Bosch Blvd.
New Bern, NC 28562
Phone: 252-672-7927
Fax: 714-845-2807
russ.warnock@bshg.com

CLAIMS APPENDIX

1 - 8 (Cancelled)

9. A storage compartment for a refrigerator door, the storage compartment comprising:

a box shaped body having a first longitudinal wall and a second longitudinal wall and a given depth extending substantially horizontally between the first and second longitudinal walls with a slot extending vertically within the first longitudinal wall at least along a portion thereof; and

a compartment divider having a rider extending downwardly spaced from a wall thereof located adjacent to said slot for being received within the slot for holding said compartment divider attached within said box shaped body, and said compartment divider defining a chamber for holding small items and extending over more than half of the given depth, wherein the compartment divider is defined by four connected walls which do not extend to a bottom of said box shaped body to define said chamber within the connected walls for holding items therein, and an open bottom for allowing items held therein to rest on said bottom of said box shaped body.

10. The storage compartment according to claim 9, wherein said compartment divider extends substantially entirely over said given depth.

11. The storage compartment according to claim 9, wherein an extent of said compartment divider in a direction of said given depth of said box-shaped body is greater than in a width direction.

12. The storage compartment according to claim 9, wherein said compartment divider has at least one sidewall with a concave shape in a direction of said given depth.

13. (Canceled)

14. The storage compartment according to claim 9, wherein said compartment divider has a given height which is less than the height of said box-shaped body.

15-16. (Canceled)

17. The storage compartment according to claim 9, wherein said slot and rider are sized to form a friction lock between said rider and walls of said box shaped body defining said slot.

18. (Canceled)

19. A storage compartment for a refrigerator door, the storage compartment comprising:

a box shaped body having a first longitudinal wall disposed adjacent to the refrigerator door, a second longitudinal wall spaced apart from the first longitudinal wall and extending substantially parallel to the first longitudinal wall, a bottom, and a slot formed in the first longitudinal wall, the box shaped body having a width dimension extending along the first longitudinal wall in a substantially horizontal direction, a depth dimension extending between the first and second longitudinal walls, and a height dimension extending along the first longitudinal wall in a substantially vertical direction;

a compartment divider including a first sidewall disposed adjacent the first longitudinal wall, a second sidewall spaced apart from the first sidewall a first

distance being more than half of the depth dimension of the box shaped body, and third and fourth sidewalls extending between the first and second sidewalls on opposing sides of the compartment divider, the compartment divider defining a chamber within the sidewalls and having an open bottom allowing items held within the compartment divider to rest on the bottom of the box shaped body; and

a rider connected to the first sidewall and extending downwardly and being received within the slot to support the compartment divider within the box shaped body.

20. The storage compartment according to claim 19, further comprising a second distance extending between the third and fourth sidewalls, the second distance being less than the first distance.

21. The storage compartment according to claim 19, wherein the third and fourth sidewalls each have a concave shape bulging inwardly toward the chamber.

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EVIDENCE APPENDIX

None

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RELATED PROCEEDINGS APPENDIX

None